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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,443	07/18/2003	Karen Luke	2000-IP-002115U1P1	4704

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary

Application No.

10/623,443

Applicant(s)

LUKE ET AL.

Examiner

Philip C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,40-47,49,53-55,58,61,62,65,106,110-121 and 125-137 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,40-47,49,53-55,58,61,62,65,106,110-121 and 125-137 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/6/06, 7/3/06, 5/8/06, 3/13/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/8/06 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 33, 43-44, 47, 55 and 135 rejected under 35 U.S.C. 102(b) as being anticipated by Kulprathipanja (4372876).

The claims are rejected for the reasons of record in the previous office action paper no. 20060214.

4. Claims 33, 40, 43-44, 47, 49, 55, 58, 61, 65, 106, 110, 113-116, 120, 135 and 136 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sirosita (4986989).

The claims are rejected for the reasons of record in the previous office action paper no. 20060214.

5. Claims 106, 113, 114 and 136 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KU (2002/0117090).

The claims are rejected for the reasons of record in the previous office action paper no. 20060214.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 33, 40-47, 49, 53-55, 58, 61, 62, 65, 106, 110-121, 125-137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaux (4548734).

Chaux teaches a composition which can comprise a gum inclusive of those of the present invention (see column 2, line 31 to column 4, line 4), and a water donor material which can be a zeolite or clay within the scope of the present invention (see column 7,

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lines 21-35). A material such as calcium carbonate, which is a weighting agent may also be used (column 8, line 10). Various surfactants, including a non-ionic monomer as claimed in claim 106 (column 10, line 36), and sulfonate surfactants such as in claim 121 (column 9, lines 1-45), may be used. The composition may be formulated as a powder, and introduced to water to form a sol (column 12, lines 30-37). Chaux differs from the present invention in that a specific example of the zeolites along with the other components is not specifically disclosed. It would however, be obvious to one of ordinary skill in the art to utilize the zeolites as the water retention material, and gums such as cellulose, given the teaching of Chaux that such are useful for forming the sol therein. Furthermore, the use of more than one water donor material, such as zeolite, clay and calcium carbonate in combination, for the the same purpose that they are individually taught useful has been held by the courts to be obvious to one of ordinary skill in the art (see *In re Kerkhoven* 205 USPQ 1069). Since such zeolite concentration may be the same as herein, such would obviously have the same properties as claims 135 -137.

8. Claims 33, 41-47, 53-55, 58, 106, 113-115, 117, 135 and 136 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/54108 in view of Ku (2002/0117090).

The claims are rejected for the reasons of record in the previous office action paper no. 20060214.

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9. Claims 33, 61-62, 106, 111-114, 118-119, 121, 125-132, and 134-137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ku in view of Roddy (6457524) and Chatterji (5588489).

The claims are rejected for the reasons of record in the previous office action paper no. 20060214.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 106, 110, 113, 114, 120 and 136 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 9, 12-15, 18, 19, 26, 29-32, 35 and 40-43 of U.S. Patent No. 6898057 (formerly 10/315415). Although the conflicting claims are not identical, they are not patentably

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distinct from each other because of the reasons of record in the previous office action paper no. 20060214..

12. Claims 33, 40-47, 49, 53-55, 58, 106, 110-117, 120, 135 and 136 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-12 and 14-31 of copending Application No. 10/795158. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons of record in the previous office action paper no. 20060214..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is noted that applicant has sent in an amendment on 7/17/06, but such has not been entered to be able to determine if the claims have been amended around the current claims. This rejection is thus based on the current claims on record.

13. Claims 33, 40-47, 53-55, 65 and 135 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 9, 14-23, 27, 28, 96, 98, 101-105, 108-110, 112, 117-121, 124-125 of copending Application No. 10/816034. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons of record in the previous office action paper no. 20060214..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 33, 40-44, 49, 53-55 and 135 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 10, 16 and 17 of copending Application No. 11/126626. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons of record in the previous office action paper no. 20060214..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 33, 40-46, 53-55, 58, 65, 106, 110-114, 117, 120, 135 and 136 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 10-16, 20-26 and 30 of copending Application No. 11/270307. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons of record in the previous office action paper no. 20060214.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Applicants amendment and arguments have been considered but are not deemed persuasive. As previously noted, a novel intended use of a composition cannot

impart patentability (In re Pearson 181 USPQ 641).. Furthermore a Property of an anticipated or obvious composition does not impart patentability to such composition (In re Tomlinson 150 USPQ 623, In re Dillon 16 USPQ2d 1897). The amendment to state a property such as being able to remove solids from a wellbore, fluid displacement from a wellbore, or physical separation of chemically incompatible fluids in a wellbore, may all be performed by the fluids disclosed in all of the references. Since water alone may perform any of these activities, it is clear that water containing the zeolite must also perform such activity. With respect to claims 135-137, applicant has not provided any evidence that the properties of such claims would not be inherent or obvious properties of the fluids disclosed in the applied prior art.

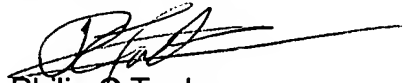
17. With respect to Ku, it is clear that a cement composition would be able to displace fluid or separate fluids in a wellbore, and thus such is not distinguished. With respect to Sobolev, it is clear that one of ordinary skill in the art of cements would look to the prior art to determine what type of zeolite is suitable for use in a cement. Thus such combination with Ku is proper.

18. With respect to the obviousness double patenting rejections, similar arguments hold. The intended use does not distinguish, and the drilling fluids or cements are able to perform the cited activity of the claims. The rejections are thus maintained. A new rejection is presented over Chaux.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Philip C Tucker
Primary Examiner
Art Unit 1712